

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1, 3-7, and 11 have been amended. Claims 2, 9 and 15 have been canceled. Thus, claims 1, 3-8, and 10-14 are currently pending in the application and subject to examination.

In the Office Action mailed July 6, 2004, the Office Action objected to the Specification and objected to claims 9 and 13-14. The Office Action further rejected claims 1-14 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action further rejected claims 1-3, 5-6, 8-9, 11-12, and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,587,979 to Kraus et al (Kraus). Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraus. Claims 4 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraus, in view of U.S. Patent No. 5,600,257 to Leas et al. (Leas). Applicants acknowledge with gratitude the indication that claims 13-14 contain allowable subject matter. It is noted that claims 2, 9, and 15 have been canceled, and claims 1, 3-7, and 11 have been amended. To the extent that the rejection(s) remain applicable to the claims currently pending, the Applicant hereby traverses the rejection, as follows.

Regarding the objection to the Specification, the Specification has been amended responsive to the Examiner's suggestion. Regarding the objection to claim 9, it is noted that this claim has been canceled by this amendment. If any additional amendment is necessary to overcome these objections, the Examiner is requested to contact the Applicant's undersigned representative.

Regarding the rejection of claims 1-14 under 35 U.S.C. § 112, second paragraph, the claims have been amended in accordance with the Examiner's suggestions. Specifically, claim 1 has been amended to include the limitations "first pattern data" and "second pattern data," and claim 5 has been amended to include the limitation "a decision circuit."

Regarding the rejection of claims 1, 3, 5-6, 8 and 11-12 under 35 U.S.C. § 102(e), this rejection is respectfully traversed. Kraus discloses a BIST circuit 7 for receiving data from a BIST controller 8. Furthermore, Krause discloses a BIST circuit for receiving data from a controller and storing it. In addition, Kraus teaches a pattern generator 50 for generating data, address and control data patterns supplied as inputs during a test. See, for example, Kraus Fig. 6, and col. 12, lines 12-29. Therefore, Kraus does not disclose a BIST circuit that previously stores first pattern data for a pattern dependency test. Furthermore, Kraus does not disclose a BOST device that previously stores second pattern data for a timing dependency test. Furthermore, Kraus teaches the pattern generator 50 is located within the core wrapper 24. The core wrapper 24 then provides the pattern directly to the RAM 12, without providing the pattern to the BIST controller 64, 68. Therefore, Kraus does not teach that the BIST controller stores pattern data.

It is noted that claim 1 has been amended by this Response. Claim 1 now recites the limitation "wherein first pattern data for a pattern dependency test is previously stored in the BIST circuit and second pattern data for a timing dependency test is previously stored in the BOST device" (emphasis added). Applicants submit that Kraus does not describe or suggest at least the limitations of first pattern data for a

pattern dependency test previously stored in the BIST circuit, and second pattern data for a timing dependency test previously stored in the BOST device, as recited in claim 1, as amended.

For at least this reason, Applicants submit that claim 1, as amended, is allowable over the cited prior art. As claim 1, is allowable, Applicants submit that claims 3-8 and 10-14, which depend from allowable claim 1, are likewise allowable over the cited prior art.

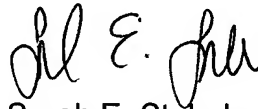
Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraus, and claims 4 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraus in view of Leas. Neither Leas nor any of the other cited art teaches at least the feature “wherein first pattern data for a pattern dependency test is previously stored in the BIST circuit and second pattern data for a timing dependency test is previously stored in the BOST device” (emphasis added), as recited in claim 1, as amended. Claims 4, 7, and 10 are dependent on claim 1 and are patentable for at least the reasons discussed above in regard to claim 1. Thus, withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

Respectfully submitted,

Arent Fox PLLC

A handwritten signature in black ink, appearing to read "Sarah E. Stahnke".

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